UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

TRUSTEES OF BOSTON UNIVERSITY, Plaintiff, vs. EVERLIGHT ELECTRONICS CO. LTD. ET AL., Defendants	C.A. No. 1:12-cv-11935-PBS
TRUSTEES OF BOSTON UNIVERSITY, Plaintiff, vs. SEOUL SEMICONDUCTOR, LTD. ET AL., Defendants	C.A. No. 1:12-cv-11938-PBS
TRUSTEES OF BOSTON UNIVERSITY, Plaintiff, vs. EPISTAR CORPORATION, Defendant	C.A. No. 12-cv-12326-PBS
TRUSTEES OF BOSTON UNIVERSITY, Plaintiff, vs. LITE-ON, INC., ET AL., Defendants	C.A. No. 12-cv-12330-PBS
TRUSTEES OF BOSTON UNIVERSITY, Plaintiff, vs. SAMSUNG ELECTRONICS CO., LTD. ET AL., Defendants	C.A. No. 13-cv-10659-PBS

TRUSTEES OF BOSTON UNIVERSITY, Plaintiff, vs. ARROW ELECTRONICS, INC., ET AL., Defendants	C.A. No. 13-cv-11105-PBS
TRUSTEES OF BOSTON UNIVERSITY, Plaintiff, vs. AMAZON.COM, INC., Defendant	C.A. No. 13-cv-11097-PBS
TRUSTEES OF BOSTON UNIVERSITY, Plaintiff, vs. APPLE INC., Defendant	C.A. No. 1:13-cv-11575-PBS

DEFENDANTS' [PROPOSED] SURREPLY BRIEF IN OPPOSITION TO PLAINTIFF'S MOTION FOR ENTRY OF ITS GLOBAL PROTECTIVE ORDER POSITIONS

In their Joint Opposition to Plaintiff's Motion for Entry of its Global Protective Order Positions (1:12-cv-11935-PBS; Dkt. 159), Defendants showed that their proposed protective order provisions were narrowly tailored to prevent misuse of Defendants' most confidential information (that which is designated as "Outside Counsel Only"). Instead of addressing Defendants' legitimate concerns about adequate protection for this information, Plaintiff's Proposed Reply (Dkt. 165-1) makes various unsubstantiated accusations about Defendants' purported ulterior motives. Defendants submit this surreply to concisely rebut several of Plaintiff's material misstatements.

First, Plaintiff asserts that inventor Dr. Theodore Moustakas "is a crucial fact witness" and that Plaintiff "needs him as an expert" (Dkt. 165-1 at 9). Nothing in Defendants' proposals for the protective order, however, affect Plaintiff's ability to call Dr. Moustakas as a fact witness. The issue is whether he should be permitted to see Defendants' most sensitive technical information as an expert—something he would have no need to do as a fact witness. Given, however, that (i) Dr. Moustakas is an active researcher in the field of LEDs who continues to apply for patents on gallium nitride technologies (the subject matter of the asserted patents), *see, e.g.*, Ex. 1, U.S. Patent Application Publication No. 2012/0058586, and (ii) he recently launched his own ultraviolet LED company (RayVio Corp.) employing gallium nitride technology, Ex. 2, there would be a significant and unwarranted risk of harm to Defendants if he were given access to their confidential technical information. *See, e.g., Applied Signal Tech., Inc. v. Emerging Markets Commc'ns, Inc.*, No. C-09-02180, 2011 WL 197811, at *5 (N.D. Ill. Jan. 20, 2011) ("An expert witness who acts as an inventor or technical advisor . . . certainly controls the content of his or her own patent applications and thus falls squarely into the parameters of competitive decisionmaking . . . ."). Moreover, Boston University, an institution with an endowment of over

$1 billion that has over the course of a year filed more than 40 patent infringement suits against more than 90 companies, certainly has the wherewithal to hire an independent expert.

Second, Plaintiff has provided no support for its assertion that Defendants' proposed language for Paragraph 11 would "prevent Boston University from obtaining any expert testimony at all." (Dkt. 165-1 at 10)[2] Plaintiff has not identified any expert it would want to use but could not use under this provision. *Compare Ares-Serono, Inc. v. Organon Int'l BV*, 153 F.R.D. 4, 5 (D. Mass. 1993). Nor does Plaintiff's rhetoric appear to be supportable. As but two examples, Defendants' proposed language would not restrict Plaintiff's ability to use an academic expert from any other university, or from using an independent consultant, so long as such expert has not recently served as a consultant for Plaintiff, Defendants, or their competitors. Indeed, Plaintiff represents in its press releases that it already has "hired consultants and laboratories to 'reverse engineer' each defendant's products" and had "[t]he analytical data … reviewed by several independent scientific experts." Ex. 3. And Plaintiff should not be heard to complain about potentially narrowed options for experts that result from its decision to sue "94 opposing parties." Indeed, most of these companies are not parties to the proposed protective order (they were sued by Plaintiff just two weeks ago, well after the parties submitted their proposals as to the protective order).

Third, Plaintiff's proposed language in Paragraph 16(a), giving Plaintiff's counsel carte blanche to participate in any role in post-grant proceedings, is not supported by the Court's July 19 ruling in the *Everlight* case (Dkt. 110), which was limited to the facts and *inter partes* review before it. Plaintiff has not provided any reason for the Court to adopt language affirming a

[2] Defendants' proposed language for Paragraph 11 requires an "Outside Consultant" to be a person "who currently or within the last three years, is not an employee of or consultant for a Party or of a competitor of an opposing Party."

"right" of Plaintiff's counsel to participate without restriction in *any* prosecution-related activity in *any* proceeding before *any* foreign or domestic agency involving not only the patents-in-suit but any "related" patent. Plaintiff itself does not defend the full breadth of its proposal, focusing on *inter partes* review proceedings of the patents-in-suit and arguing that Defendants' confidential information "is irrelevant to prior art analyses" (Dkt. 165-1 at 8). Yet, Plaintiff ignores that it has the ability, in post-grant proceedings such as reexaminations, to seek new claims intended to cover Defendants' products but avoid the prior art. *Cf. In re Deutsche Bank Trust Co. Ams.*, 605 F. 3d 1373, 1380 (Fed. Cir. 2010) (recognizing the "much greater" risk when litigation counsel is involved in "strategically amending or surrendering claim scope during prosecution").

Finally, as to Defendants' request that one of Plaintiff's counsel be precluded from access to "Outside Counsel Only" information given specific facts set forth in Defendants' Opposition, Defendants simply note that Mr. Shore admits in reply that 80% of his practice is based on asserting patents against semiconductor companies (further confirming the need for a patent acquisition bar); that he has admittedly filed more than 40 actions against more than 90 purported infringers here (both manufacturers and customers); that there are unique facts concerning his ownership interest in a semiconductor company which asserts such patents; and that he has expressed a desire to use discovery in these proceedings as a basis to obtain information to file further cases. (1:12-cv-11935-PBS; Dkt. 110, at 6) (rejecting Plaintiff's argument that it "should be able to use discovery in this case to identify customers of the defendants . . . and bring suit on the basis of that information").

Dated: October 4, 2013

Respectfully submitted,

EVERLIGHT ELECTRONICS CO., LTD. AND EVERLIGHT AMERICAS, INC.

EPISTAR CORPORATION

LITE-ON, INC., LITE-ON SERVICE USA, INC., LITE-ON TRADING USA, INC., AND LITE-ON TECHNOLOGY CORP.

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CERTIFICATE OF SERVICE

I hereby certify that this document filed through the ECF system will be sent electronically to the registered participants as identified on the Notice of Electronic Filing (NEF) and paper copies will be sent to those indicated as non-registered participants on October 4, 2013.

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